

Supreme Court, U. S.
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IN THE
Supreme Court of the United States

October Term, 1978

No. **79-330**

Masanao Matsui, Tomoya Ogawa

and

Rikagaku Kenkyusho, Petitioners

v.

C. Marshall Dann, Commissioner of
Patents and Trademarks, Respondent

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA CIRCUIT

Petitioners pray that a writ of certiorari issue to review the judgment herein of the United States Court of Appeals for the District of Columbia Circuit entered in the above-entitled case on March 29, 1979, petition for rehearing denied on May 31, 1979.

OPINIONS BELOW

By Order of the United States District Court for the District of Columbia dated October 21, 1977, Respondent's Motion to Dismiss was treated by the Court as one for summary judgment; and U.S. District Court Judge George L. Hart, Jr. issued an Order Granting Summary Judgment in favor of Respondent. The Order appears in Appendix A, infra, and is unreported. The judgment of the U.S. Court of Appeals for the District of Columbia Circuit, filed on March 29, 1979, which affirmed the judgment of the District Court, is unreported and appears in Appendix B, infra. The Orders of the Court of Appeals, filed on May 31, 1979, denying Petitioners' petition for rehearing and suggestion for rehearing en banc, are unreported and appear in Appendix C, infra. On August 3, 1979, Petitioners filed in the Court

of Appeals their Motion to Recall and Stay Mandate, a copy of which appears in Appendix D.

JURISDICTION

The judgment of the Court of Appeals was entered on March 29, 1979; the petition for rehearing and suggestion for rehearing en banc filed by Petitioners was denied on May 31, 1979. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

QUESTION PRESENTED

Under the mandates of the U.S. Constitution and the Patent Act of 1952, does the Commissioner of Patents and Trademarks have the authority to withhold the filing date of a patent application, and thus jeopardize the issuance of a patent on the application, where the original application contained an inadvertent

error as to the "form" of the oath or declaration required to be submitted, where the informality of the oath or declaration was corrected within two days of the original application filing date, and where the original application has made a timely, full and complete disclosure of the inventors' new, useful and unobvious invention?

STATUTE AND REGULATIONS INVOLVED

The statute involved is the Patent Act of 1952, as amended, Title 35 of the United States Code (1976). The relevant provisions are 35 U.S.C. Sections 25, 111, 115, 116, 118, and 119. Because these provisions are lengthy, their pertinent text is set forth as Appendix E, infra. The Regulations involved are Patents, Trademarks and Copyrights Regulations, Title 37 of the Code of Federal Regulations (1976). The relevant provisions are 37 C.F.R. Sections 1.45(c), 1.47(b), 1.51 and 1.65(a) and (b). These provisions are also

lengthy and, therefore, their pertinent text is set forth as Appendix F, infra.

STATEMENT OF THE CASE

This case arises under the provisions of the Administrative Procedure Act, 5 U.S.C. Sections 702-704, and relates to an action in the nature of mandamus to compel the Respondent, Commissioner of Patents and Trademarks, to award Petitioners a filing date of October 26, 1976, for their patent application which was filed under the provisions of 35 U.S.C. Section 118 and 37 C.F.R. Section 1.47(b).

The Respondent's refusal to allow Petitioners the filing date of October 26, 1976, causes the effective loss of the one year convention priority period under the International Convention for the Protection of Industrial Property, as implemented by 35 U.S.C. Section 119, which

may effectively preclude issuance of a patent to Petitioners for an invention which relates to a possible cancer cure.

Facts

On October 26, 1976, Petitioner Rikagaku Kenkyusho filed an application for Letters Patent in the United States Patent and Trademark Office, Serial No. 735,777, entitled "NOVEL PROCESS FOR PRODUCING PYRIMIDINE NUCLEOSIDES AND NOVEL PYRIMIDINE NUCLEOSIDES OBTAINED THEREBY", in the name of the inventors, Petitioners Masanao Matsui and Tomoya Ogawa (hereinafter sometimes referred to as Matsui and Ogawa, respectively), which application is the subject of the instant Petition (hereinafter referred to as the "instant Matsui et al U.S. application"). The application relates to chemical compounds that are used in the treatment of cancer.

Preliminary to the events in question, Petitioner Rikagaku, through its Japanese patent agents, Nakamura, Yamamoto, Takeda and Partners, (hereinafter sometimes referred to as "Nakamura et al") filed the following seven applications for patent in Japan, in connection with the subject matter of the instant Matsui et al U.S. application: Japanese Application Nos. 128020/75 and 128022/75 filed October 24, 1975; 144637/ 1975 filed December 4, 1975; 180/1976 filed January 5, 1976; 27836/1976 filed March 15, 1976; 27837/1975 filed March 15, 1976; and 53463/1976 filed May 11, 1976. Certified copies of these seven Japanese applications were filed in the Patent and Trademark Office on October 13, 1977, during proceedings in the District Court.

On October 8, 1976, Petitioners' Japanese patent agents, Nakamura et al forwarded the instant

Matsui et al U.S. application to Petitioner Rikagaku, together with an assignment of the application to Petitioner Rikagaku to be executed by the inventors, Petitioners Matsui and Ogawa, who were employees of Rikagaku. The instant Matsui et al U.S. application, and the assignment thereof, were received by Rikagaku on October 12, 1976, were executed by the inventors, Matsui and Ogawa, on the same date, and thereafter immediately forwarded to Nakamura, Yamamoto, Takeda and Partners to be forwarded to the United States for filing in the Patent and Trademark Office. The application, including specification, claims, original Declaration duly executed by Matsui and Ogawa, and the executed assignment, were received by Nakamura, Yamamoto, Takeda and Partners on Saturday, October 16, 1976, and was thereafter mailed on Monday, October 18, 1976 to Petitioners' U.S. representatives, Fleit & Jacobson, in Washington, D.C..

Since the instant Matsui et al U.S. application claimed priority under the International Convention for the Protection of Industrial Property pursuant to 35 U.S.C. §119^{1/}, based upon the seven previously filed Japanese applications, the last day for filing the instant Matsui et al U.S. application was October 26, 1976.^{2/} To insure that the application was filed on or before October 26, 1976, and to thereby preserve the Convention "priority" date, on October 18, 1976, Nakamura et al

^{1/} Section 119 provides, in effect, that a U.S. patent application filed within one year of the applicant's corresponding foreign application, will have, as its "priority" date, the filing date of the foreign application.

^{2/} The one year priority period, based upon the earliest filed Japanese applications, Nos. 128020/75 and 128022/75, filed October 24, 1975, was to have expired on October 26, 1976, in view of the fact that October 24 was a Sunday and October 25 was a legal Holiday.

telexed Petitioners' U.S. representatives, Fleit & Jacobson, advising that the executed application had been airmailed that day, and instructing that Nakamura et al should be contacted by telex if the papers were not received in the United States by the October 26, 1976 priority deadline.

Having previously received an unsigned confirmation copy, but not the original, of the priority application papers, on October 26, 1976, Martin Fleit of Petitioners' U.S. representatives, Fleit & Jacobson, telephoned Mr. Minoru Nakamura of Nakamura, Yamamoto, Takeda and Partners, and advised Mr. Nakamura that the instant Matsui et al application had not yet been received. During this telephone conversation, Mr. Nakamura appointed Martin Fleit as agent-in-fact to act for and on behalf of Rikagaku Kenkyusho, to file the instant Matsui

et al U.S. application pursuant to 35 U.S.C. §118 and 37 C.F.R. §1.47(b).

Immediately thereafter, pursuant to his aforesaid authorization, Martin Fleit filed the instant Matsui et al application in the Patent and Trademark Office on October 26, 1976, as agent for, and on behalf of the Japanese company Rikagaku Kenkyusho, said application comprising a petition, specification and claims, and the duly executed Declaration of Martin Fleit (a copy of which appears in Appendix G, infra), as required by the pertinent provisions of the Patent Act, Title 35 U.S. Code, and the pertinent Patent and Trademark Office Rules, 37 Code of Federal Regulations.

On October 27, 1976, the original application papers and assignment executed by the inventors Matsui and Ogawa on October 12, 1976, and airmailed by Nakamura, Yamamoto,

Takeda and Partners on October 18, 1976, were received by Fleit & Jacobson and, thereafter, the original executed application was duly filed in the Patent and Trademark Office on October 28, 1976.

On January 11, 1977, Petitioners, through their U.S. representatives, received an "Action" by the Patent and Trademark Office advising that the instant Matsui et al application, as filed on October 26, 1976, was considered to be "incomplete" under 37 C.F.R. Section 1.47(b) on the grounds that the record failed to establish, (1) Martin Fleit's authority to execute the application; (2) the proprietary interest of Petitioner Rikagaku; (3) that a diligent effort had been undertaken to find or reach the inventors, Petitioner Matsui and Ogawa, prior to filing the application on October 26, 1976; (4) the last known addresses of the

inventors, Matsui and Ogawa, or (5) their relationship to Rikagaku; (6) that the application papers only identified Petitioners Matsui and Rikagaku, and not Petitioner Ogawa; and (7) the application papers did not contain a "declaration" as required by 37 C.F.R. Section 1.65(b) and 35 U.S.C. Sections 111 and 115. A copy of said "Action" appears in Appendix H, infra.

On January 27, 1977, Petitioners' U.S. representative met with the Patent and Trademark Office Solicitor, Joseph F. Nakamura, and Assistant Solicitor Harry I. Moatz, during which the Patent and Trademark Office Action of January 11, 1977, was discussed in detail. Thereafter, on February 2, 1977, Petitioners filed the Assignment of the application to Rikagaku, as executed by Petitioners Matsui and Ogawa and, on March 30, 1977, Petitioner filed a "Letter", together with the Declaration of the

inventors Matsui and Ogawa, Mr. Minoru Nakamura of Nakamura et al, and Rikagaku's president, Mr. Shinju Fukui, as a supplemental showing in an effort to overcome the objections set forth in the Patent and Trademark Office Action of January 11, 1977.

On April 26, 1977, a further "Action" was issued by the Patent and Trademark Office, in which it was held that although the instant Matsui et al U.S. application complied with the requirements of 37 C.F.R. Section 1.47(b), Petitioners were denied the requested October 26, 1976 filing date on the grounds (1) that Martin Fleit's Declaration, as filed with the application papers on October 26, 1976, failed to comply with all of the statutory requirements relating to a proper declaration, as required in 35 U.S.C. Sections 25, 111 and 115, and 37 C.F.R. Sections 1.51 and 1.65(b), and (2) that the application failed to identify all of the inven-

tors, i.e., Petitioner Ogawa. A copy of this "Action" appears in Appendix I infra.

Thereafter, on or about May 3, 1977, Petitioners' representatives again met with Solicitor Nakamura and Assistant Solicitor Moatz, during which said Patent and Trademark Office representatives indicated that the April 26, 1976 Action was final, and thereby again denied Petitioners the requested October 26, 1976 filing date, taking the position that neither the Patent Statute, nor Title 37 of the Code of Federal Regulation (the Patent and Trademark Office Rules), applicable to patent applications, could be construed so as to permit the Patent and Trademark Office the authority and/or discretion to accept the application as "complete" on October 26, 1976, for the purpose of obtaining a filing date.

On May 16, 1977, Petitioners filed a "Letter" in the Patent and Trademark Office, acknowledging and confirming the finality of the May 3, 1977 Action, and specifically reserving Petitioners' right to accept October 28, 1976, as the filing date of the instant Matsui et al application, pending judicial review.

Proceedings in the District Court

Having exhausted all of their administrative remedies, on June 3, 1977, Petitioners brought suit in the U.S. District Court for the District of Columbia in the nature of mandamus to compel the Respondent, Commissioner of Patents and Trademarks, to award Petitioners a filing date of October 26, 1976, for their patent application. This action arises under the Administrative Procedure Act, 5 U.S.C. Sections 702-704, based upon the

provisions of 35 U.S.C. Sections 25, 111, 115, 116 and 118, 37 C.F.R. Sections 1.45(c), 1.47(b), 1.51 and 1.65(b), on the ground that the Respondent has abused his discretion in failing to accord Petitioners a filing date of October 26, 1976, for their patent application. The basis for federal jurisdiction in the District Court was founded upon 5 U.S.C. Sections 702-704 and 28 U.S.C. Sections 1338 and 1361. A copy of the Complaint filed in the District Court appears in Appendix J infra.

The case was tried by United States District Court Judge George L. Hart, Jr. upon Respondent's Motion to Dismiss for failure to state a claim upon which relief can be granted, treated by the Court as one for summary judgment. On October 21, 1977, Judge Hart issued an Order Granting Summary Judgment.

Proceedings in the Court of Appeals

On October 31, 1977, Petitioners appealed the District Court's Order Granting Summary Judgment to the U.S. Court of Appeals for the District of Columbia Circuit basing the appeal mainly upon the decision of the Court of Appeals in A.F. Stoddard & Co. Ltd. v. Dann, 564 F.2d 556 (D.C. Cir. 1977). On March 29, 1979, the Court of Appeals affirmed the District Court's Order Granting Summary Judgment without opinion, stating only that the instant Matsui et al application "...does not comply with the requirements of 35 U.S.C. §115 (1976)." The Petition for Rehearing and Rehearing en banc filed by Petitioners on April 12, 1979, was denied by the Court of Appeals by Orders filed on May 31, 1979.

The Petitioners now seek review of this case in this Court.

REASONS FOR GRANTING THE WRIT

The Court of Appeals for the District of Columbia has rendered a decision in this action which is in obvious conflict with its previous opinion in A.F. Stoddard & Co. Ltd. v. Dann, 564 F.2d 556 (D.C. Cir. 1977)^{3/} and, more importantly, is in conflict with the mandates of the United States Constitution and decisions of this Court as set forth in Stoddard, supra, concerning what is "form" and what is "substance" relative to a patent application filed pursuant to the Patent Act, 35 U.S.C. Sections 1 et seq. Therefore, this Petition raises substantial and important questions concerning the

^{3/} The decision in Stoddard was authored by Chief Judge Markey of the Court of Customs and Patent Appeals, sitting by designation pursuant to 28 U.S.C. §293(a). Judge Markey was not a member of the panel of the Court of Appeals which heard this action.

administration of the patent laws, and the constitutional and statutory right to patent protection for those inventors who, by the filing of patent applications, make full and complete disclosures of their new, useful and unobvious inventions.

The decision of the Court of Appeals totally overlooks, disregards and/or does not even deal with the fact that Petitioners' patent application, as originally filed, provided the Government with a full disclosure of Petitioners' invention, and included a declaration which contained sufficient facts upon which to find compliance with 35 U.S.C. Section 115; the Court of Appeals' decision therefore, places form over substance contrary to the mandate of its own decision in A.F. Stoddard, supra, which sets forth the requirements of the Constitution as interpreted by this Court.

In A.F. Stoddard & Co. Ltd., supra, a U.S. patent application was filed which included a declaration pursuant to 35 U.S.C. Section 115, signed by one not the inventor. Seven years later, after a patent had issued on the application, the plaintiff filed a reissue patent application under 35 U.S.C. Section 251 seeking to correct the original Section 115 declaration to name the actual inventor rather than the incorrect party who was originally named. In allowing the reissue application in the name of the original inventor, notwithstanding the fact that the original application had been incorrectly filed, the Court of Appeals quoted from Chief Justice Marshall in Grant v. Raymond, 31 U.S. (6 Peters) 218, 8 L.Ed.376 (1832), and explained the basic judicial policies of justice and equity which governed the Court of Appeals in Stoddard, and which must govern this case as well:

To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our constitution, and the power "to promote the progress of science and useful arts, by securing for limited times right to their respective writings and discoveries," is among those expressly given to congress. This subject was followed the organization of our government. It was taken up by the first congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c. on his petition, "granting to such petitioner, his heirs, administrators or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, using, and vending to

others to be used, the said invention or discovery". ...It [the patent] is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received: if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its

enjoyment by the discoverer for fourteen [now seventeen] years, is preserved; and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake. [Emphasis added] 564 F.2d at 563.

In defining what is "form" and what is "substance", the Court of Appeals in Stoddard noted the words of Chief Justice Burger in Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 480-81, 40 L.Ed.2d 315 (1974), for the proposition founded in the Constitution that the "quid pro quo" received by the Government as consideration for the grant of a patent is simply the full and adequate disclosure of a new, useful and unobvious invention, and stated:

In this context [a purpose-defeating application of the Patent Act], the only things that are really matters of substance are whether the invention is new, useful and unobvious and whether it is adequately disclosed in the patent specification. Everything else can be thought of as a matter of form. When an invention is new, useful and unobvious and is suitably disclosed, the public has received everything the patent laws are intended to give it in return for the grant of a patent. C. Marshall Dann, "Form and Substance in Patent Matters", 57 J. Pat. Off. Soc'y., 202, 203-04 (1976) [Emphasis added]. 564 F.2d at 566, n. 13.^{4/}

^{4/} It is to be noted that the above-quoted language was expressed by the Respondent, Commissioner of Patents

Applying the above-quoted philosophy, the Stoddard Court then stated:

Applying the views of Chief Justice Marshall and Chief Justice Burger, we note first that there has been a full and adequate disclosure of the inventions in the present case. On the record here the inventions are themselves patentable. One patent has issued and its reissue is now sought. A patent based on the continuation application appears warranted. The filing documents show Walser as the inventor. We now know that the inventor was Hospied. To permit the requested

4/ (continued) and Trademarks, himself. Yet, the Patent and Trademark Office has still refused to ward Petitioners here their requested filing date simply due to an inadvertent omission as to form.

substitution of names would on this record harm no one. To deny the requested correction, on the other hand, would serve no useful purpose, would frustrate the constitutional objective, would exalt form over substance, and would punish Stoddard's commendable candor, all to the injury of the patent system and to him to whom it must appeal, i.e., the inventor. The United States has fully received its quid pro quo, the disclosures, one of which has been published and the other is to be published upon correction of the inventor's name, and should not now deny the formal step requested. A denial would, in sum, violate that "sense of justice" which Chief Justice Marshall saw as pleading "strongly against depriving the inventor" just "because he has committed an inadvertent or

innocent mistake,"
Grant v. Raymond,
supra, and could
preclude the "positive
effect on society"
referred to by Chief
Justice Burger in
Kewanee, supra.
[Emphasis added] 564
F.2d 564.

Petitioners submit that the present case is no different and, in fact, is stronger than that before the Court of Appeals in Stoddard. Here, an application was filed on October 26, 1976, containing all of the statutory requisites, except for a declaration signed by the inventors. Instead, and only because the original application papers signed by the inventors were delayed in the mail, a declaration was filed pursuant to 35 U.S.C. Section 118, signed by Martin Fleit, the U.S. patent attorney for the inventors and named assignee, which referred to the inventors' seven previously filed Japanese applications upon which the instant Matsui et al application was based.

The application as filed on October 26, 1976, was therefore complete, and provided the Government and the public with a "quid pro quo" for the grant of a patent in that it offered a full and complete disclosure of a new, useful and unobvious invention and, by referring to the identified Japanese applications, listed the identity of Petitioners Matsui and Ogawa as the inventors, and their citizenship. If the application, as filed on October 26, 1976, was deficient in any respect, it was merely as to form and not as to substance, and such deficiency was simply the result of an inadvertent, harmless and innocent error on the part of Petitioners' attorneys, not Petitioners, which was immediately rectified by the original application filed on October 28, 1976, which was identical to the application filed two days earlier, except for the inclusion of a declaration signed by the inventors, Petitioners Matsui and Ogawa.

These circumstances are really no different than the situation in Stoddard, where the declaration accompanying the original application was signed by Walser claiming to be the inventor when, in fact, Hospied was the true inventor. To hold, as the Court of Appeals has in its March 29, 1979 judgment, that the declaration of Walser in Stoddard, claiming that he was the original and first inventor, is more valid than the declaration of Martin Fleit which, by referring to the noted Japanese applications, identifies Petitioners Matsui and Ogawa as the inventors of the instant Matsui et al application is, we submit, to place form over substance, contrary to the constitutional mandates expounded in Stoddard.

Moreover, the present case goes further than the facts in Stoddard for here, one of the original and first joint inventors, Petitioner

Matsui, was specifically identified in the Fleit declaration filed with the application, whereas in Stoddard, the actual inventor was not identified until approximately seven years later. Further, a duly executed declaration, naming both inventors, and signed by both, was filed in the Patent and Trademark Office on October 28, 1976, only two days after the application papers filed by Martin Fleit. Even if the Patent and Trademark Office was correct in not looking to the noted Japanese applications for the identification of Petitioner Ogawa as a joint inventor, the application would still not have been deficient since Petitioner Ogawa could have been added as a joint inventor under the provisions of 35 U.S.C. Section 116 (third paragraph).^{5/}

^{5/} In this regard, the Stoddard Court specifically held that

The Constitution speaks of "securing" to inventors the

Stated in the simplest of terms, it is an aberration of justice, and certainly in conflict with constitutional mandates and with the

5/ (continued)

exclusive right to their discoveries, not that the inventor must "apply". Thus, the Constitution is result-oriented and contemplates that the "grant" of the patent be to the inventor, either directly or indirectly through his assignee....

* * * * *

Thus, the fact that the true inventor was not named in the...U.S. application (1966) raises no constitutional bar... To the contrary, the constitutional objective of "granting" a patent (or a reissue patent) "to" the true inventor will be, and can only be, served by permitting the requested correction. [Emphasis added] 564 F.2d at 562

At least one commentator has agreed with Stoddard as not requiring the true inventor to be identified in a patent application so long as the patent is "secured" to the inventor. See, Welch, Stoddard v. Dann -- Fundamental Principles From A To C, 61 Journal of the Patent Office Society, Vol. 4, p. 185 (April 1979).

Court of Appeals' previous mandate in Stoddard, to allow the decision complained of herein to stand. Specifically, the Court of Appeals placed substance over form in Stoddard by acknowledging that even where a wrong inventor signed a declaration in a patent application the application and the resulting patent were valid and could be subsequently corrected (seven years later). How can it be that, in the present case, a patent application filed in the name of at least one of the correct inventors, containing a declaration which simply omits the so-called magic words of 35 U.S.C. Section 115 -- "original and first inventor" -- is not subject to the same consideration? This is particularly unconscionable where, as here, an application containing a declaration previously signed by the inventors, both Petitioners Matsui

and Ogawa, was delayed in the mail from Japan, through no fault of the Petitioners, and was in the Patent and Trademark Office only two days after filing of the original application. Can it be that the omission of the magic words "original and first inventor" in the application filed on October 26, 1976, was not subject to later correction? The answer must obviously be no, since the Patent and Trademark Office routinely accepts "substitute declarations" without affecting the original filing date of an application. The same negative answer must also be dictated by Stoddard which allowed the substitution of a declaration by the actual inventor for one filed by a non-inventor seven years earlier without affecting the original filing date. To say that the application as filed herein on October 26, 1976, was incomplete simply as a result of the omission of the magic words "original and first"

inventor is to place form over substance, in the most literal sense, contrary to the constitutional mandates expounded in Stoddard.

To further demonstrate the absurdity of placing form over substance in this case, as the lower Courts have done, it is noted that the Patent and Trademark Office would have accepted the Matsui et al application as of October 26, 1976, if it contained a declaration signed by Petitioners' U.S. attorney, Martin Fleit, which stated, in effect, that "On information and belief, Masano Matsui and Tomoya Ogawa are believed to be the original and first inventors...". Had these magic words been included in the Fleit declaration, Petitioners would not now be before this Court since the Patent and Trademark Office would have awarded the application the October 26, 1976 filing date. This would have been so notwithstanding the fact

that Martin Fleit, in so executing such a declaration, might have had no actual knowledge that Petitioners Matsui and Ogawa were the original and first inventors of the subject application. Instead, the Fleit declaration in question specifically identified seven Japanese patent applications which named Petitioners Matsui and Ogawa as the inventors of the subject invention. It is therefore incomprehensible that this should not be sufficient compliance with 35 U.S.C. Section 115, at least for the purpose of awarding the October 26, 1976 filing date, subject to later submission of a declaration (which was filed two days later) as signed by the actual inventors and which was in full compliance with 35 U.S.C. Section 115. Can it be legitimately contended that filing and acceptance of a declaration on information and belief, without actual factual support, is in compliance with the 35 U.S.C. Section

115, whereas the Fleit declaration which was filed and which identified the inventors by reference to their seven Japanese patent applications is not? Again, this is simply a case of blindly placing form over substance, contrary to the constitutional mandates expounded in Stoddard.

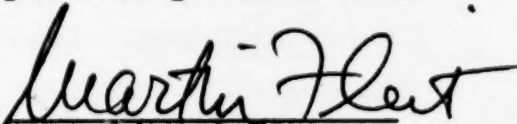
To uphold the decisions of the lower Courts which have affirmed the decision of the U.S. Patent and Trademark Office in this case is to allow the continuance of placing form over substance in the prosecution of patent applications before the Patent and Trademark Office contrary to the fundamental principles of the U.S. Constitution as interpreted by this Court and expounded in Stoddard. A failure to review this case will cause the lower federal Courts to flounder as to what standards to apply concerning matters of form and matters of substance in reviewing decisions of positions taken by the

Patent and Trademark Office. Furthermore, the bolstering and clarification of the fundamental principles of the U.S. Constitution by this Court will hopefully protect possible patentees from the sin too often committed by the Patent and Trademark Office of rigidly applying inflexible interpretations of the Patent Act to deny patent grants where the full and complete disclosures of new, useful and unobvious inventions have been made by inventor - patent applicants.

CONCLUSION

The Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

By: 

Martin Fleit
Simor L. Moskowitz
FLEIT & JACOBSON
2033 M Street, N.W.
Washington, D. C.
20036
(202) 466-8800
Counsel for
Petitioners

A P P E N D I C E S

APPENDIX

- A. October 21, 1977, Order of the U.S. District Court for the District of Columbia.
- B. March 29, 1979, Judgment of the U.S. Court of Appeals for the District of Columbia.
- C. May 31, 1979, Orders of the U.S. Court of Appeals for the District of Columbia.
- D. August 3, 1979, Motion to Recall and Stay Mandate.
- E. 35 U.S.C. §§25, 111, 115, 116, 118 and 119.
- F. 37 C.F.R. §§1.45(c), 1.47(b), 1.51 and 1.65(a)-(b).
- G. October 26, 1979 Declaration of Martin Fleit.
- H. January 11, 1977, Action of the Patent and Trademark Office.
- I. April 26, 1977, Action of the Patent and Trademark Office.
- J. Complaint filed in the U.S. District Court for the District of Columbia.

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

MASANAO MATSUI, TOMOYA OGAWA,)
and RIKAGAKU KENKYUSHO)
Plaintiffs)

v.)

C. MARSHALL DANN,)
Commissioner of Patents)
and Trademarks)

Defendant)

Civil Action No. 77-0968

FILED ✓
OCT 21 1977

JAMES F. DAVEY, Clerk

ORDER GRANTING SUMMARY JUDGMENT

The defendant having filed a motion to dismiss the complaint for failure to state a claim upon which relief can be granted, and the Court having been fully advised in the premises and having heard argument of counsel thereon, and it appearing to the Court that there is no dispute of material fact concerning the filing of the application involved in the Patent Office, and it further appearing to the Court that the application filed October 26, 1976 is not in conformance with the requirements of the applicable statutes and regulations, and the Court being of the opinion that the Commissioner of Patents has no discretion to pre-date the valid application of October 28, 1976 to October 26, 1976,

the date the incomplete and defective application was filed,
it is by the Court this 21st day of October, 1977,

ORDERED that the Motion to Dismiss be, and the same is,
treated as a Motion for Summary Judgment, and the Motion
for Summary Judgment be, and the same is hereby, granted.


UNITED STATES DISTRICT JUDGE

NOTED - SEE LOCAL RULE 13(f)

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

[No Opinion]

No. 77-2062

September Term, 1978

MASANAO MATSUI et al., Appellants Civil Action No. 77-0968
United States Court of Appeals
for the District of Columbia Circuit

v.

DONALD BANNER, Commissioner
of Patents and Trademarks

FILED MAR 29 1979

Appeal from the United States District Court for the Dis-
trict of Columbia. GEORGE A. FISHER

Before: WRIGHT, Chief Judge, and SWYGERT* and ROBB, Cir-
cuit Judges.

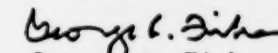
JUDGMENT

This cause came on to be heard on the record on appeal from
the United States District Court for the District of Columbia and
was argued by counsel. While the issues presented occasion no
need for an opinion, they have been accorded full consideration
by the court. See Local Rule 13(c).

The application in suit does not comply with the require-
ments of 35 U.S.C. § 115 (1976).

On consideration of the foregoing, it is ORDERED and ADJUDGED
by this court that the judgment of the District Court appealed
from in this cause is hereby affirmed.

Per Curiam*
For the Court


George A. Fisher
Clerk

* Of the Seventh Circuit, sitting by designation pursuant to
28 U.S.C. § 291(a) (1976).

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 77-2001

September Term, 1976

Mansanao Matsui, et al.,
Appellants

v.

C. Marshall Dann,
Commissioner of Patents
and TrademarksUnited States Court of Appeals
for the District of Columbia Circuit

FILED MAY 31 1976

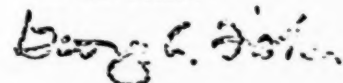
GEORGE A. FISHER
CLERKBEFORE: Wright, Chief Judge; Bazelon, McGowan, Tamm, Leventhal,
Robinson, MacKinnon, Robb, and Wilkey, Circuit JudgesORDER

The suggestion for rehearing en banc filed by appellants Mansanao Matsui, et al., having been transmitted to the full Court and no judge in regular active service having requested a vote with respect thereto, it is

ORDERED, by the Court, that appellants' aforesaid suggestion for rehearing en banc is denied.

Per Curiam

FOR THE COURT:


GEORGE A. FISHER
Clerk

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 77-2001

September Term, 1976

Mansanao Matsui, et al.,
Appellants

v.

C. Marshall Dann,
Commissioner of Patents
and TrademarksUnited States Court of Appeals
for the District of Columbia Circuit

FILED MAY 31 1976

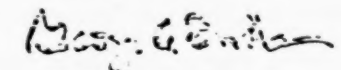
GEORGE A. FISHER
CLERKBEFORE: Wright, Chief Judge; Swygert*, Circuit Judge, United
States Court of Appeals for the Seventh Circuit, and
Robb, Circuit JudgeORDER

Upon consideration of appellants' petition for rehearing, it is

ORDERED, by the Court, that appellants' aforesaid petition for rehearing is denied.

Per Curiam

FOR THE COURT:


GEORGE A. FISHER
Clerk

*Sitting by designation pursuant to Title 28 U.S.C. § 291(a).

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

MASANAO, MATSUI,	:	
TOMOYA OGAWA, and	:	
RIKAGAKU KENKYUSHO,	:	
Appellants	:	
v.	:	
C. MARSHALL DANN, Commissioner	:	Appeal No. 77-2062
of Patents and Trademarks,	:	
Appellee	:	

On appeal from the United States District Court
for the District of Columbia

MOTION TO RECALL AND STAY MANDATE

Appellants, Masanao Matsui, Tomoya Ogawa and Rikagaku Kenkyusho, through their undersigned counsel, respectfully move this Court for an Order recalling from the U. S. District Court for the District of Columbia and staying the mandate issued July 12, 1979, pending application to the Supreme Court of the United States for a writ of certiorari in this action.

By letter dated July 12, 1979, the Clerk of this Court transmitted to the Clerk of the U.S. District Court for the District of Columbia, in lieu of mandate, a certified copy of the judgment of this Court filed on May 31, 1979, and a certified copy of bill of costs in the amount of \$591.00 in the above-entitled case.

Presently, Appellants are preparing to file a timely petition for writ of certiorari to the Supreme Court requesting a full review of this case in accordance with 28 USC §2101 et seq. The petition for writ of certiorari must be filed within ninety days of entry of judgment, May 31, 1979; therefore, Appellants shall file their petition for writ of certiorari with the Clerk of the Supreme Court no later than August 29, 1979.

Therefore, to maintain the status quo of this matter pending possible review by the Supreme Court, this action which has been transmitted to the U. S. District Court for the District of Columbia, should be recalled by this Court so that the mandate may be stayed pending Appellants' application to the Supreme Court for a writ of certiorari in accordance with Rule 41(b) of the Federal Rules of Appellate Procedure. Furthermore, in accordance with Rule 41(b), once this stay is granted and this Court receives notice from the Clerk of the Supreme Court that Appellants have filed their petition for the writ in that Court, the stay shall continue until final disposition by the Supreme Court.

WHEREFORE, Appellants respectfully request that their Motion be granted.

Respectfully submitted,
FLEIT & JACOBSON

By: Simor L. Moskowitz
Martin Fleit
Simor L. Moskowitz
2033 M Street, N.W.
Washington, D. C. 20036
Attorneys for Appellants

CERTIFICATE OF SERVICE

I hereby certify that two copies of the foregoing Motion for Recall and Stay were served via first class mail, postage prepaid, upon Joseph F. Nakamura, Solicitor, United States Patent and Trademark Office, Washington, D. C. 20231, this 3RD day of August, 1979.

Simor L. Moskowitz

STATUTES AND REGULATIONS

35 U.S.C. 25

§ 25. Declaration in lieu of oath

(a) The Commissioner may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Commissioner may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001). (New section added March 26, 1964, Public Law 88-292, sec. 1, 78 Stat. 171; amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

Note.—18 U.S.C. 1001 provides: "Whoever in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not more than \$10,000 or imprisoned not more than five years, or both." (June 25, 1948, 62 Stat. 749)

35 U.S.C. 111

§ 111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

§ 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the inventor or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

§ 119. Benefit of earlier filing date in foreign country; right of priority

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the

application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing. (Amended October 3, 1961, Public Law 87-333, sec. 1, 75 Stat. 748; July 28, 1972, Public Law 92-358, sec. 1, 86 Stat. 502; and January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

35 U.S.C. 115

§ 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

35 U.S.C. 116

§ 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

§ 1.45 Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must sign the application papers and make the required oath or declaration: neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) If an application for patent has been made through error and without any deceptive intention by two or more persons as joint inventors when they were not in fact joint inventors, the application may be amended to remove the names of those not inventors upon filing a statement of the facts verified by all of the original applicants, and an oath or declaration as required by § 1.65 by the applicant who is the actual inventor, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

(c) If an application for patent has been made through error and without any deceptive intention by less than all the actual joint inventors, the application may be amended to include all the joint inventors upon filing a statement of the facts verified by, and an oath or declaration as required by § 1.65 executed by, all the actual joint inventors, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

[24 FR 10332, Dec. 22, 1959, as amended at 29 FR 18503, Dec. 29, 1964]

§ 1.47 Filing by other than inventor.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. Such application must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.65. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. Such application must be accompanied by proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.65. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

[24 FR 10332, Dec. 22, 1959, as amended at 29 FR 18503, Dec. 29, 1964; 34 FR 18857, Nov. 28, 1969]

§ 1.51 General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks. A complete application comprises:

(1) A specification, including a claim or claims, see §§ 1.71 to 1.77.

(2) An oath or declaration, see §§ 1.65 and 1.68.

(3) Drawings, when necessary, see §§ 1.81 to 1.88.

(4) The prescribed filing fee. (See 35 U.S.C. section 41 for filing fees.)

(b) Applicants are encouraged to file a prior art statement at the time of filing the application or within three months thereafter. See §§ 1.97 through 1.99.

[42 FR 5593, Jan. 28, 1977]

§ 1.65 Oath or declaration.

(a)(1) The applicant, if the inventor, must state that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used in the United States before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented or made the subject of an inventor's certificate in any foreign country prior to the date of his application on an applica-

tion filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. He must acknowledge a duty to disclose information he is aware of which is material to the examination of the application. He shall state whether or not any application for patent or inventor's certificate on the same invention has been filed in any foreign country, either by himself, or his legal representatives or assigns. If any such application has been filed, the applicant shall name the country in which the earliest such application was filed, and shall give the day, month, and year of its filing; he shall also identify by country and by day, month, and year of filing, every such foreign application filed more than twelve months before the filing of the application in this country.

(2) This statement (I) must be subscribed to by the applicant, and (II) must either (a) be sworn to (or affirmed) as provided in § 1.66, or (b) include the personal declaration of the applicant as prescribed in § 1.68. See § 1.153 for design cases and § 1.162 for plant cases.

(b) If the application is made as provided in §§ 1.42, 1.43, or 1.47, the applicant shall state his relationship to the inventor and, upon information and belief, the facts which the inventor is required by this section to state.

(c) An additional statement may be required if the application has not been filed in the Patent and Trademark Office within a reasonable time after execution of the original statement.

(Sec. 1, 78 Stat. 171; 35 U.S.C. 25, 26)

[29 FR 18503 Dec. 29, 1964, as amended at 34 FR 18857, Nov. 26, 1969; 42 FR 5594, Jan. 28, 1977]

In re the Application of

Nakanishi MATSUI et al

Filed: October 26, 1976

For: NOVEL PROCESS FOR PRODUCING PYRIMIDINE NUCLEOSIDES
AND NOVEL PYRIMIDINE NUCLEOSIDES OBTAINED THEREBY

DECLARATION

I, MARTIN FLEIT, a citizen of the United States,
residing in the County of Fairfax, Virginia, hereby declare:

1) THAT I am a partner in the law firm of FLEIT &
Jacobson and a registered patent attorney (Registration No.
16,900).

2) THAT on October 18, 1976, I was instructed by ex-
Japanese associates, Nakamura, Yamamoto, Takeda & Partners,
Tokyo, Japan, to file in the United States an application for
patent based on Japanese application Nos. 128020/75 and
128022/75 filed October 24, 1975;

3) THAT I am informed and believe that Nakamura,
Yamamoto, Takeda & Partners are patent agents for the Japanese
company Rikagaku Kenkyusho, who have a sufficient proprietary
interest in the application to warrant proceeding under
37 CFR 1.47(b);

4) THAT the telex of October 18, 1976, from Nakamura,
Yamamoto, Takeda & Partners advised that the executed application
papers had been airmailed from Tokyo on October 18, 1976;

5) THAT as of the close of business today, October 26,
1976, the expected executed application papers have not been
received in our offices, and I have not been contacted by an
air cargo office that they have arrived for pick-up by our office;

444637/1975, filed December 4, 1975, 180/1976 filed January 3,
1976, 27836/1976, filed March 15, 1976, 27837/1975, filed
March 15, 1976 and 53463/1976 filed May 11, 1976.

6) THAT by virtue of a telephone conference on
October 26, 1976, I have been authorized to act as agent for the
assignee company for filing an application for patent in the
United States on the above invention;

7) THAT I am informed and believe that the right to
file the above application may be seriously prejudiced, the
advantage of the inventors' rights under the International
Convention for the Protection of Industrial Property may be
lost, and irreparable damage may result, if this application is
not placed on file and a filing date of no later than
October 26, 1976 obtained.

8) THAT in view of the emergency situation, lack
of time in which to receive executed application papers from
the inventors, prior to expiration of the Convention priority
term, I am acting as agent for Rikagaku Kenkyusho, and will
file joinder papers in the Patent and Trademark Office as soon
as they are received.

I further declare that all statements made herein
of my own knowledge are true and that all statements made on
information and belief are believed to be true; and further
that these statements were made with the knowledge that willful
false statements and the like so made are punishable by fine
or imprisonment, or both, under Section 1001 of Title 18 of the
United States Code, and that such willful false statements may
jeopardize the validity of the application or any patent issuing
thereon.

Martin Fleit
Martin Fleit

October 26, 1976
Washington, D.C. 20036



**U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

January 11, 1977

In re Application of
Matsuo Matsui et al.
Serial No. 735,777

Deposited: October 26, 1976

For: NOVEL PROCESS FOR PRODUCING PYRIMIDINE NUCLEOSIDES
AND NOVEL PYRIMIDINE NUCLEOSIDES OBTAINED THEREBY

Receipt is acknowledged of papers deposited as a patent application pursuant to 35 U.S.C. 118 and 37 CFR 1.47(b) on October 26, 1976 by Kagaku Kenkyusho on behalf of Matsui et al.

Applications deposited pursuant to 35 U.S.C. 118 and 37 CFR 1.47(b) are reviewed for compliance with the provisions of M.P.E.P. 409.03(b) [3rd Ed., Rev. 47, 1976].

The papers cannot, at this time, be accepted as a patent application and assigned a filing date of October 26, 1976.

Receipt on October 28, 1976 is further acknowledged of application papers executed by Matsui and Ogawa.

The papers deposited on October 26, 1976, failed to provide a satisfactory showing of the authority of Mr. Fleit to execute the application, the proprietary interest of the 37 CFR 1.47(b) applicant in the proposed application's subject matter, that diligent efforts were in fact undertaken to find or reach the omitted inventors, state the last known addresses of the omitted inventors and the relationship of the 37 CFR 1.47(b) applicant to the omitted inventors.

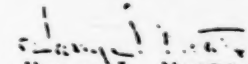
Furthermore, the declaration executed by Mr. Fleit did not name all the omitted inventors, and no other paper deposited on October 26, 1976 named all the inventors. More significantly, the papers deposited on October 26, 1976 did

Serial No. 735,777

not contain a 37 CFR 1.65(b) declaration as required by 35 U.S.C. 111, 115. Consequentially, the application was incomplete as of October 26, 1976, and an October 26, 1976 filing date cannot be assigned to the application.

Inasmuch as papers constituting a complete application were present in this Office as of October 28, 1976 in view of the deposit of the executed application papers deposited on said date, consideration will to be given to assigning the proposed application a filing date of October 28, 1976 if it is requested in writing.

Any response to this letter should be taken within two months from the date hereof and should be directed to my attention.


Harry L. Moatz
Assistant Solicitor

Fleit & Jacobson
1320 19th Street, N.W.
Washington, D. C. 20036



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

26 APR 1977

In re Application of
Masanao Matsui et al.
Serial No. 735,777
Deposited: October 26, 1976
For: NOVEL PROCESS FOR PRODUCING
PYRIMIDINE NUCLEOSIDES AND
NOVEL PYRIMIDINE NUCLEOSIDES
OBTAINED THEREBY

Receipt is acknowledged of papers deposited on March 30, 1977, in support of depositing the above-identified proposed application pursuant to 35 U.S.C. 118 and 37 CFR 1.47(b).

Included among the papers are (1) declarations by inventors Masanao Matsui and Tomoya Ogawa acknowledging that the 37 CFR 1.47(b) applicant had a proprietary interest in the matter by virtue of an assignment they executed on October 12, 1976, (2) a declaration by Shinji Fukui, president of Rikagaku Kenkyusho, the 37 CFR 1.47(b) applicant, confirming and ratifying Martin Fleit's authority and acts as agent for the 37 CFR 1.47(b) applicant in depositing the instant proposed application, and (3) a declaration by Minoru Nakamura, a partner in the Japanese patent firm of Nakamura, Yamamoto, Takeda & Partners, setting forth the manner in which the inventors' signatures on the application papers were secured on October 12, 1976, and the mailing thereof on October 18, 1976, to Fleit & Jacobson, 1320-19th Street, N.W. Washington, D.C. 20036.

Receipt is further acknowledged of an assignment signed by inventors Masanao Matsui and Tomoya Ogawa, deposited on February 2, 1977.

A review of the record indicates compliance with the provisions of 37 CFR 1.47(b).

However, the record and Mr. Fleit's comments, deposited on March 30, 1977, fail to respectively exhibit or be convincing that the papers deposited on October 26, 1976, contained an oath in accordance with 35 U.S.C. 111, 115 and 37 CFR 1.65(b) or declaration in lieu of said oaths pursuant to 35 U.S.C. 25.

Serial No. 735,777

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Mr. Fleit's comments on the inventors' identity are unpersuasive. The recitation of "Masanao Matsui et al" in Mr. Fleit's declaration does not identify any particular person other than Matsui. Furthermore, it has not been established that the listed Japanese patent applications provided the necessary information on the inventors' identities as of October 26, 1976. For instance, certified copies of the Japanese patent applications were not deposited in the proposed application and made available for inspection as of October 26, 1976. Moreover, it has not been shown that the Japanese patent applications were available for public inspection as of October 26, 1976.

Contrary to Mr. Fleit's comments, it is not apparent that 37 CFR 1.45(c) is pertinent to the present situation. In the words of 37 CFR 1.45(c), the provision applies "If an application for patent has been made * * * by less than all the actual joint inventors * * *." Thus, where an application for patent is not made by an actual joint inventor, 37 CFR 1.45(c) is not applicable. See *Becton, Dickinson & Co. v. Sherwood Medical Industries Inc.*, 516 F.2d 514, 187 USPQ 200 (CA5 1975). Inasmuch as the proposed application was deposited by Rikagaku Kenkyusho and was not signed by an actual joint inventor, 37 CFR 1.45(c) is not germane.

Furthermore, the deposit of the proposed application has been made pursuant to the provisions of 35 U.S.C. 115, 118 and 37 CFR 1.47(b), 1.51, and 1.65(b) inasmuch as no inventor signed the proposed application papers deposited on October 26, 1976. Inasmuch as Mr. Fleit has not established that 37 CFR 1.45(c) was promulgated for the purpose of accepting proposed patent applications which are not signed by an actual inventor or determining whether an oath or declaration complies with 35 U.S.C. 115 and 37 CFR 1.65(b), the comments regarding 37 CFR 1.45(c) are not found to be relevant.

Turning now to the sufficiency of Mr. Fleit's October 26, 1976 "DECLARATION" to comply with the requirements of 35 U.S.C. 115 and 37 CFR 1.65(b), Mr. Fleit's comments are not persuasive of error in the Assistant Solicitor's initial finding that the papers deposited on October 26, 1976, did not contain a 37 CFR 1.65(b) declaration or oath as required by 35 U.S.C. 111, 115. Contrary to Mr. Fleit's assertion, the "name(s) of the inventor(s)" were not provided in the "DECLARATION." Moreover, the "DECLARATION" did not state that the inventors believe themselves to be the "original and first" inventors of

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the process and composition of matter for which they solicit a patent, or state "what country [they are] a citizen" as required by 35 U.S.C. 115, first sentence.

Mr. Fleit specifically relies on the latter portion of the last sentence of 35 U.S.C. 115, to urge that the variation in form of his declaration complies therewith. As stated in the last sentence of 35 U.S.C. 115, "the oath may be so varied in form that it can be made by him." However, 35 U.S.C. 115 does not provide for any instance where the oath may be varied in substance. Inasmuch as Mr. Fleit's "DECLARATION" does not contain the substantive statements required by 35 U.S.C. 115, it does not amount to a declaration pursuant to 35 U.S.C. 25 in lieu of the required oath. Even the Commentary to Section 115 relied upon by Mr. Fleit does not provide even a nuance that the substance of the oath required by statute may be varied to the point of omission.

Inasmuch as the papers deposited on October 26, 1976, did not contain an oath pursuant to 35 U.S.C. 115 or a declaration in lieu thereof pursuant to 35 U.S.C. 25, the papers deposited on said date do not constitute a complete application. 35 U.S.C. 111; 37 CFR 1.51. Consideration will be given, if requested in writing, to assigning a filing date of October 28, 1976, to the papers deposited on October 28, 1976, inasmuch as all parts of an application were on deposit as of said date.

Any response hereto should be made within two months from the date hereof, and should be directed to my attention.


Harry I. Moatz
Assistant Solicitor

Fleit & Jacobson
2033 M. Street, N.E.
Washington, D. C. 20036

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

MASANAO MATSUI)
No. 13-3-507, 2-chrome, Shirasagi,)
Nakano-ku)
Tokyo, JAPAN)

and)

TOMOYA OGAWA)
No. 22-15, 3-chrome,)
Kichijojiminami-cho)
Musashino-shi)
Tokyo, JAPAN)

and)

RIKAGAKU KENKYUSHO)
No. 2-1, Hirosawa, Wako-ski)
Saitama-ken)
JAPAN)

Plaintiffs,)

v.)

C. MARSHALL DANN,)
COMMISSIONER OF PATENTS)
AND TRADEMARKS)
Washington, D.C. 20231)

Civil Action No.

COMPLAINT IN THE NATURE OF MANDAMUS
TO COMPEL COMMISSIONER OF PATENTS AND
TRADEMARKS TO AWARD FILING DATE

1. The Plaintiff, MASANAO MATSUI (hereinafter sometimes "Matsui") is a citizen of Japan, residing at No. 13-3-507, 2-chrome, Shirasagi, Nakano-ku, Tokyo, Japan.
2. The Plaintiff TOMOYA OGAWA (hereinafter sometimes "Ogawa"), is a citizen of Japan, residing at No. 2215, 3-chrome, Kichijojiminami-cho, Musashino-shi, Tokyo, Japan.

3. The Plaintiff, RIKAGAKU KENKYUSHO (hereinafter sometimes "Rikagaku"), is a corporation duly organized and existing under the laws of Japan, located and doing business at No. 21, Hirosawa, Wako-shi, Saitama-ken, Japan.

4. The Defendant, C. Marshall Dann, is the Commissioner of Patents and Trademarks of the United States, a legal resident of the District of Columbia, and is here sued as Commissioner of Patents and Trademarks of the United States, an agency of the U.S. Department of Commerce.

5. This is an action seeking judicial review and reversal of a "final agency action" by the Commissioner of Patents and Trademarks refusing to award Plaintiffs a filing date of October 26, 1976 for U.S. Patent Application, Serial No. 735,777.

6. This action arises under the provisions of Title 35 of the United States Code, Sections 25, 111, 115, 116 and 118, 37 C.F.R. §§ 1.45(c), 1.47(b), 1.51 and 1.65(b), and on the ground that the Commissioner of Patents and Trademarks has abused his discretion in failing to accord Plaintiffs a filing date of October 26, 1976 for Patent Application, Serial No. 735,777. The jurisdiction of this Court is founded upon 5 U.S.C. §§ 702-704, and 28 U.S.C. §§ 1338 and 1361, as hereinafter more fully appears.

7. The Plaintiffs, on October 26, 1976, filed an application for Letters Patent in the United States Patent and Trademark Office, Serial No. 735,777 entitled "NOVEL PROCESS FOR PRODUCING PYRIMIDINE NUCLEOSIDES AND NOVEL PYRIMIDINE NUCLEOSIDES OBTAINED THEREBY", in the name of the

inventors, Plaintiffs Matsui et al, which application is the subject of the instant action (hereinafter the "instant Matsui et al U.S. application").

8. Preliminary to the events in question, Plaintiff Rikagaku, through its Japanese patent agents, Nakamura, Yamamoto, Takeda and Partners, (hereinafter sometimes "Nakamura et al") filed seven applications for patents in Japan, in connection with the subject matter of the instant Matsui et al U.S. application.^{2/} On October 8, 1976, Nakamura, Yamamoto, Takeda, and Partners forwarded the instant Matsui et al U.S. application to Plaintiff Rikagaku to be executed by the inventors, Plaintiffs Matsui and Ogawa, who were employees of Rikagaku, together with an assignment of the application to Plaintiff Rikagaku. The instant Matsui et al U.S. application, and the assignment thereof, were received by Plaintiff Rikagaku on October 12, 1976, and were executed by the inventors, Plaintiffs Matsui and Ogawa, on the same date, after which they were immediately forwarded to Nakamura, Yamamoto, Takeda and Partners to be forwarded to the United States for filing in the Patent and Trademark Office. The application, including specification, claims, formal drawing, original Declaration duly executed by Plaintiffs Matsui and Ogawa, and the executed assignment, was received by Nakamura, Yamamoto, Takeda and Partners on Saturday, October 16, 1976,

^{2/} Japanese Application Nos. 128020/75 and 128022/75 filed October 24, 1975; 144637/1975 filed December 4, 1975; 180/1976 filed January 5, 1976; 27836/1976, filed March 15, 1976; 27837/1975, filed March 15, 1976; and 53463/1976, filed May 11, 1976.

and was thereafter mailed on Monday, October 18, 1976 to Plaintiffs' U.S. representatives, Fleit & Jacobson, (Patent and Trademark Office Registration No. 25,211), at 1320-19th Street, N.W., Washington, D.C. 20036.

9. Since the instant Matsui et al U.S. application claimed priority under the International Convention for the Protection of Industrial Property, as implemented by 35 U.S.C. §§ 119, based on the seven previously filed Japanese applications, the last day for filing the instant Matsui et al U.S. application was October 26, 1976.**/ To insure that the application was filed on or before October 26, 1976, and to thereby preserve the "priority" date, on October 18, 1976, Nakamura et al telexed Plaintiffs U.S. representatives, Fleit & Jacobson, advising that the executed application had been airmailed that day, and instructing that Nakamura, et al should be contacted by telex if the papers were not received in the United States by the priority deadline.

10. Not having received the priority application papers on or before October 26, 1976, Martin Fleit of Plaintiffs' U.S. representatives, Fleit & Jacobson, telephoned Mr. Minoru Nakamura of Nakamura, Yamamoto, Takeda and Partners, and advised Mr. Nakamura that the instant Matsui et al application had not yet been received. During this telephone conversation, Mr. Nakamura appointed Martin Fleit as agent-

**/ The one year priority period, based upon the earliest filed Japanese applications, Nos. 128020/75 and 128022/75, filed October 24, 1975, was to have expired on October 26, 1976, in view of the fact that October 24 was a Sunday and October 25 was a legal holiday.

in-fact to act for and on behalf of Rikagaku Kenkyusho, to file the instant Matsui et al U.S. application pursuant to 35 U.S.C. § 118 and 37 C.F.R. 1.47(b). Thereafter, pursuant to his aforesaid authorization, Martin Fleit filed the instant Matsui et al application in the Patent and Trademark Office on October 26, 1976, said application comprising specification and claims, formal drawings and the duly executed Declaration of Martin Fleit, as required by the pertinent provisions of the Patent Statute, Title 35 U.S. Code, and the pertinent Patent and Trademark Office Rules, 37 Code of Federal Regulations.

11. On October 27, 1976, the original executed application papers and assignment, airmailed by Nakamura, Yamamoto, Takeda and Partners on October 18, 1976, were received by Fleit & Jacobson, and thereafter the original executed application was duly filed in the Patent and Trademark Office on October 28, 1976.

12. Subsequently, on January 11, 1977, Plaintiffs, through their U.S. representatives, received an "Action" by the Patent and Trademark Office advising that the instant application, as filed on October 26, 1976, was considered to be "incomplete" under 37 C.F.R. 1.47(b) on the grounds that the record failed to establish, (1) Martin Fleit's authority to execute the application; (2) the proprietary interest of Plaintiff Rikagaku; (3) that a diligent effort had been undertaken to find or reach the inventors, Plaintiffs Matsui

and Ogawa, prior to filing the application on October 26, 1976; (4) the last known addresses of the inventors, Plaintiffs Matsui and Ogawa, or (5) their relationship to Rikagaku; (6) that the application papers only identified Plaintiffs Matsui and Rikagaku, and not Plaintiff Ogawa; and (7) the application papers did not contain a declaration as allegedly required by 37 C.F.R. 1.65(b) and 35 U.S.C. §§ 25, 111 and 115.

13. On January 27, 1977, Plaintiffs U.S. representatives met with the Patent and Trademark Office Solicitor, Joseph Nakamura, and Assistant Solicitor Harry I. Moatz, during which the Patent and Trademark Office Action of January 11, 1977 was discussed in detail. Thereafter, on February 2, 1977, Plaintiffs filed the Assignment of the application to Rikagaku, as executed by Plaintiffs Matsui and Ogawa and, on March 30, 1977, Plaintiffs filed a "Letter" together with the Declarations of Plaintiffs Matsui and Ogawa, Mr. Minoru Nakamura, and Rikagaku's president, Mr. Shinju Fukui, as a supplemental showing in an effort to overcome the objections set forth in the Patent and Trademark Office Action of January 11, 1977.

14. On April 26, 1977, a further "Action" was issued by the Patent and Trademark Office, in which it was held that the instant Matsui et al U.S. application complied with the requirements of 37 C.F.R. § 1.47(b), but which unreasonably, improperly and illegally denied Plaintiffs the

requested October 26, 1976 filing date on the alleged basis that the filing of Martin Fleit's Declaration with the application papers on October 26, 1976, failed to comply with all of the statutory requirements relating to a proper declaration as required in 35 U.S.C. Sections 25, 111 and 115 and 37 C.F.R. § 1.45(c), 1.51 and 1.65(b), and that the application failed to identify all of the inventors, i.e., Plaintiff Ogawa.

15. Thereafter, on or about May 3, 1977, Plaintiffs' representatives again met with Solicitor Nakamura and Assistant Solicitor Moatz, during which said Patent and Trademark Office representatives indicated that the April 26, 1976 Action was final, and thereby again unreasonably, improperly and illegally denied Plaintiffs the requested October 26, 1976 filing date, taking the position that neither the Patent Statute nor Title 37 of the Code of Federal Regulation (the Patent and Trademark Office Rules) applicable to patent applications could be construed so as to permit the Patent and Trademark Office the discretion to accept the application as "complete" on October 26, 1976, for the purpose of obtaining a filing date.

16. On May 16, 1977, Plaintiffs filed a "Letter" in the Patent and Trademark Office, acknowledging and confirming the finality of the May 3, 1977 Action, and specifically reserving Plaintiffs' right to accept October 28, 1976 as the date of the instant Matsui et al application, pending review by this Court.

17. Plaintiffs have exhausted all of their administrative remedies.

18. The Commissioner of Patents and Trademarks unreasonably, improperly and illegally failed to discharge his duties and responsibilities imposed upon him by 35 U.S.C. § 25, 111, 115 and 118, in connection with the instant Matsui et al U.S. application.

19. The Commissioner of Patents and Trademarks acted arbitrarily and capriciously, in abuse of his discretion, and in violation of 35 U.S.C. § 25, 111, 115 and 118, in denying Plaintiffs a filing date of October 26, 1976, for the instant Matsui et al U.S. application based upon the submission of a "complete" application which included a Declaration signed by Plaintiff Rikagaku's agent-in-fact, Martin Fleit, and which identified all of the inventors, either specifically or by reference to the aforesaid previously filed Japanese applications.

20. The Commissioner of Patents and Trademarks acted arbitrarily and capriciously, in abuse of his discretion, and in violation of 35 U.S.C. § 25, 111, 115 and 118, in denying Plaintiffs the requested October 26, 1976 filing date for the instant Matsui et al application, where the application filed on October 26, 1976, included a duly executed Declaration of Plaintiffs' agent-in-fact, which names the inventors as , Matsui et al, and referred to seven Japanese applications filed by the same inventors and where

the application was "ratified" by the prompt submission, on October 28, 1976, of the original application papers (i.e. joinder papers), which conformed exactly to the application papers filed on October 26, 1976, duly executed by all of the inventors.

21. The Commissioner of Patents and Trademarks acted arbitrarily and capriciously, and abused his discretion in unreasonably and unlawfully denying Plaintiffs an October 26, 1976 filing date for the instant Matsui et al U.S. application, thereby withholding from Plaintiffs the constitutional and statutory right to a patent where an invention is new, useful and unobvious, and curtailing the rights of foreign applicants under the aforesaid International Convention, of which the United States is a member.

22. The Commissioner of Patents and Trademarks has misinterpreted the Patent Laws as embodied in 35 U.S.C. § 25, 111, 115 and 118, in taking the position that the Patent and Trademark Office is forbidden to grant a filing date on the basis of the duly signed Declaration of Plaintiffs agent-in-fact, in compelling circumstances such as these.

23. The Commissioner of Patent and Trademark has misinterpreted the Patent Laws, particularly 35 U.S.C. § 115, and has acted arbitrarily and capriciously, in abuse of his discretion, in unreasonably and unlawfully denying Plaintiffs an October 26, 1976 filing date based upon a Declaration executed by Plaintiffs' agent-in-fact which was

so varied in form that it could be made by him, as provided in 35 U.S.C. § 115.

24. The Commissioner of Patent and Trademark has acted arbitrarily, capriciously, and in abuse of his discretion, in unreasonably and unlawfully denying Plaintiffs an October 26, 1976 filing date, by misinterpreting 35 U.S.C. § 115 and failing to distinguish between the elements to be included in an oath or declaration as required by 35 U.S.C. § 115 and the Patent and Trademark Office Rules, respectively.

25. The Commissioner of Patent and Trademark has acted arbitrarily, capriciously, and in abuse of his discretion, and has exceeded his authority, promulgating a rule, 37 C.F.R. § 1.65(a), which is inconsistent with the requirements imposed by the last sentence of 35 U.S.C. § 115.

26. The Commissioner of Patent and Trademark has acted arbitrarily, capriciously, and in abuse of his discretion in not adhering to his own rules, specifically 37 C.F.R. § 1.65(a), which requires that certain statements be included in an oath or declaration submitted with an application for patent, only if made by the "inventor".

27. The Commissioner of Patent and Trademark has acted arbitrarily, capriciously, and in abuse of his discretion in not adhering to the statute, 35 U.S.C. § 116, and his own rules, specifically 37 C.F.R. § 1.45(c), which

provides for amendment of an application to include or name a joint inventor(s) who was not included in the application through error, and with out deceptive intent.

WHEREFORE, Plaintiffs pray that this Court:

1) Decree that Plaintiffs are entitled to receive an October 26, 1976 filing date for the instant Matsui et al U.S. application (U.S. Serial No. 735,777);

2) Direct the Commissioner of Patents and Trademarks to award U.S. Serial No. 735,777 a filing date of October 26, 1976; and

3) Award Plaintiffs such other and further relief as the Court may deem proper and just.

MARTIN FLEIT
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By: Martin Fleit
Attorneys for Plaintiffs

OF COUNSEL:

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Certificate of Service

I, MARTIN FLEIT, one of the attorneys for Petitioners herein, and a member of the Bar of the Supreme Court of the United States, hereby certify that, on the 29th day of August, 1979, I served copies of the foregoing PETITION FOR WRIT OF CERTIORARI as follows:

1. On the Commissioner of Patents and Trademarks of the United States, by mailing three copies, in a duly addressed envelope, via first class mail, postage prepaid, to Joseph F. Nakamura, Esq., Solicitor, United States Patent and Trademark Office, Washington, D.C. 20231, attorney of record in this matter; and

2. On the United States, by mailing three copies, in a duly addressed envelope, via first class mail, postage prepaid, to the Solicitor

General, Department of Justice,
Washington, D. C. 20530.

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